

## R E M A R K S

The Office communication states that the reply filed on January 28, 2003 is not fully responsive because an amended portion of claim 7 is not commensurate with the previous version of the claim. Applicant has corrected the defect in this reply.

Claims 1-18 are pending in this application. Of these, claims 10-18 stand withdrawn from consideration per applicant's previous election to prosecute claims 1-9. Claims 3, 4 and 7 have been amended with this response.

### Re Application Papers:

It is noted that in the present official action that there has been no objection to the specification, drawings, proposed drawing corrections, the oath or declaration.

### Re: Priority:

It is noted that acknowledgment has been made of applicant's claim for foreign priority under 35 USC 119 and that all certified copies of the priority documents have been received.

### Re IDS:

The specification of this application discusses a prior art reference EPO 706 178. In section (4) of the official action the examiner reminded applicant that 37 CFR 198(b) requires that prior art must be presented in a separate paper for consideration by the examiner. With this response, applicant would like the prior art mentioned in the specification to be considered. Accordingly, a copy of EPO 706 178 was submitted on April 15, 2003 in a supplementary IDS.

Consideration of applicant's supplementary IDS, when available, is respectfully requested.

5    Re Amended Claim 7:

In the official action, dependent Claim 7 was *objected* to on Form PTO-326 but not otherwise discussed in the official action. It is presumed that this rejection was based on the rejection of its base claim (1). No other grounds of rejection were mentioned.

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In view of the foregoing, dependent Claim 7 has been placed in independent form including all of the limitations of its base claim (1). As amended to independent form, Claim 7 is therefore now allowable and such action is respectfully requested.

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Re Claims 3-5:

Dependent claims 3-5 were rejected under 35 USC 112. In applying this rejection, the examiner stated that "The terms 'too low' and 'which suffices' are relative and vague terms. It is not readily  
20    apparent what structure they encompass."

It is respectfully submitted that the expression "too low" is not a relative and vague term in this claim. This is because the claim clearly states that the transmission factor of one group of layers is lower than  
25    the lowest transmission factor, which allows to pass through said group of layers a quantity of light, which is sufficient for writing operation on the other layer. Of course, depending on characteristics of the other layer, this transmission factor may change, but in dependency on said characteristics. It is further noted, that the laser power cannot be

increased indefinitely, because (a) laser sources are not able to generate indefinite power, and (b) layers to be passed do not stand indefinite power.

5        Notwithstanding the foregoing, and in view of clarifying the inventive features of Claim 3, this dependent claim has been amended to overcome this ground of rejection by the recitation that the total transmission factor is "...lower than the lowest transmission factor that allows to pass through said information carrier layer with associated  
10 covering layer and separating layer a quantity of light being sufficient for a writing operation on the other information layer."

As amended, dependent Claim 3 is submitted to clearly overcome the rejection under 35 USC 112 and is in allowable  
15 condition. Dependent Claim 4 has been similarly and is also allowable. Dependent Claim 5 is allowable at least for the same reasons as amended dependent Claim 4.

Reconsideration and allowance of dependent claims 3-5 is  
20 believed to be in order and is respectfully requested.

Re Claims 1, 2, 8 and 9:

Claims 1, 2, 8 and 9 were rejected under 35 USC 102 as being anticipated by Nagashima (US 5,876,823). This rejection is  
25 respectfully traversed for the following reasons.

Nagashima shows in Fig. 1 that both layers 2 and 6 are provided with a reflective layer 3 and 7, respectively. In Figure 5, it is shown that layer 52 is coated with a semi-transparent film 53 but layer 56 is

provided with a reflective film 57. Nagashima, therefore, does neither show nor give a hint to make both layers semi-transparent as recited in Claim 1.

5       As to Claim 2, Nagashima shows that at least one of the layers is reflective, which means that both layers "can not" be "read from both sides". Even if both layers of the Nagashima disclosure would be provided with a recordable film, they could not be read from both sides. The claimed feature of claim 2 is, therefore neither shown nor made  
10       obvious by Nagashima. Claims 8 and 9 are allowable at least for the same reasons as Claim 1.

Re Claim 6.

      Claim 6 was rejected under 35 USC 103 as being unpatentable  
15       over Nagashima. In applying this rejection, it is acknowledged that Nagashima is silent as to the separating layer having an additional information carrier layer. No art is cited for the claimed further layer. It is submitted that claim is thus clearly allowable at least for the same reasons as its base claim (1).

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Fees:

      As originally filed, this case contained six (6) independent claims and a total of nineteen (19) claims. As amended, Claim 7 has been placed in independent form. Please charge the cost of this added  
25       independent claim to applicant's Deposit Account Number 07-0832. A separate paper was enclosed (in duplicate) in the reply dated January 22, 2003 authorizing this charge.

The application, as amended, is believed to be in condition for allowance and such action is respectfully requested.

Please address all communications to:  
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Respectfully submitted,

  
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Certificate of Mailing Pursuant to 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in a postage paid envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. on the date indicated below.

4-25-03

Date Deposited

Karen M. Schlauch  
Signature

Marked Up Copy of Amended Claims Showing Changes Made

3. (Once Amended) Optical recording medium according to claim 2, wherein the total transmission factor of an information carrier layer [(2, 3)] with associated covering layer [(4, 5)] and separating layer [(8)] is lower than the lowest transmission factor that allows to pass through said information carrier layer with associated covering layer and separating layer [too low to allow] a quantity of light [which suffices] being sufficient for a writing operation [to pass ] on the other information carrier layer [(3, 2)].

4. (Once Amended) Optical recording medium according to Claim 1, wherein the total transmission factor of an information carrier layer [(2, 3)] with associated covering layer [(4, 5)] and separating layer [(8)] is lower than the lowest transmission factor that allows to pass through said information carrier layer with associated covering layer and separating layer [too low to allow] a quantity of light [which suffices] being sufficient for a writing operation [to pass to] on the other information carrier layer [(3, 2)].

7. (Once Amended) Optical recording medium [according to claim 1,] comprising two information carrier layers, on which information can be written by means of a focused light beam, a separating layer arranged between said information carrier layers, and a transparent covering layer, which is arranged between said information carrier layer and a surface of the recording medium and whose thickness substantially exceeds that of said information carrier layer, wherein: both information carrier layers are semi-transparent and wherein the transmission factor of the information carrier layers [(2, 3)], given the presence of two information layers [(2, 3)], is less than 10%.